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Thomas Weiss

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EXAMINER

TALBOT, BRIAN K

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS WEISS, JAMES N. HUMENIK,
MARK J. LAPLANTE, and DAVID C. LONG

Appeal 2009-009861
Application 10/645,384
Technology Center 1700

Before TERRY J. OWENS, BEVERLY A. FRANKLIN,
and KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-23. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 1 is illustrative (emphasis added)¹:

1. A method of dispensing a flowable material onto a workpiece comprising:

providing a dispensing apparatus comprising an orifice member having first and second surfaces and a bore therethrough between the surfaces, a pressurized chamber adjacent the orifice member first surface for flowable material, and a punch having a face movable through the orifice member bore;

providing a flowable material in the chamber;

positioning the punch outside the orifice member bore such that the punch face is spaced from the orifice member first surface;

flowing a desired amount of flowable material onto the punch face;

moving the punch and desired amount of flowable material on the punch face through the orifice member bore until the punch face extends beyond the orifice member second surface;

contacting the workpiece with the desired amount of flowable material while still on the punch face;

depositing the desired amount of flowable material onto the workpiece; and

retracting the punch until the punch face is substantially coplanar with the orifice member second surface.

¹ Independent claim 20 is similar to claim 1, and each claim requires the step of “retracting the punch until the punch face is substantially coplanar with the orifice member second surface”.

Appellants appeal the following rejections²:

Claims 1, 3-11, and 14-19 under 35 U.S.C. § 103(a) as unpatentable over Blette (US 5,186,982 issued Feb. 16, 1993);

Claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over Blette in combination with Banno (US 6,761,925 B2 issued Jul. 13, 2004) or Speakman (US 6,503,831 B2 issued Jan. 7, 2003);

Claims 20, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over Blette in combination with Hess (US 2003/0119193 A1 issued Jun. 26 2003); and

Claim 21 under 35 U.S.C. § 103(a) as unpatentable over the combined prior art of Blette, Hess, and Bibeault (US 6,775,879 B2 issued Aug. 17, 2004).

ISSUE

Did the Examiner err in finding that Blette teaches or suggests “retracting the punch face until the punch face is substantially coplanar with the orifice member second surface” as recited in independent claims 1 and 20?

We answer this question in the affirmative.

PRINCIPLES OF LAW

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007), quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). As stated by the Federal Circuit:

² The Examiner has withdrawn all rejections based on Brooks or Bryning made in the Final Office Action (Ans. 2).

[The claims] are part of “a fully integrated written instrument,” . . . consisting principally of a specification that concludes with the claims. For that reason, claims “must be read in view of the specification” [T]he specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.”

Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc) (internal citations omitted).

ANALYSIS

with Factual Findings

Appellants contend that, contrary to the Examiner’s findings, Blette does not reasonably teach or suggest “retracting the punch *until the punch face is substantially coplanar with the orifice member second surface*” as recited in claims 1 and 20 (emphasis added; Ans. 4; Reply Br. 2; *see also* App. Br. 11 (“Blette shows no such retracted position wherein the face of pin 22 is coplanar . . . as in appellants method”)). Appellants argue that the Examiner’s position that Blette teaches the recited step because the pin of Blette would be substantially coplanar with the orifice twice between the retracted and deposited positions of Blette (Ans. 4), is “simply not reasonable” (Reply Br. 2). We agree.

Appellants’ Specification makes it clear that this claimed step is directed to the embodiment as shown in Fig. 3A and 3F, that is, “the park or idle position” of the punch (Spec. 11:8-9; Spec. 11:18-22; Spec. 12:18-22; *see also* Spec. 9:25-26 (“When sitting idle the punch is positioned such that the tip of the punch is flush with the bottom of the orifice”)). Indeed, the Specification clearly distinguishes between the idle position of Figs. 3A and

3F, wherein the punch face is retracted until it is coplanar with the lower surface of the orifice bushing, and another retracted position as shown in Fig. 3B, wherein these surfaces are not coplanar as required by claims 1 and 20, and that allows a desired amount of conductive paste to flow onto the punch face (*compare*, Spec. 11:18-20 and Spec. 12:18-22 to Spec. 11:24-28).

The Examiner has not explained how Blette's retracting of its pin *past* the orifice open surface would have taught or suggested retracting the pin until the pin is coplanar with the orifice second surface (i.e., to "a park or idle position" (Spec. 11:8-9) of coplanar surfaces as shown in Fig. 3A) according to the broadest reasonable interpretation of the claim language consistent with the Appellants' Specification. Therefore, we are persuaded that the Examiner's interpretation of the claim language is overly broad and not reasonable. As such, we cannot sustain the obviousness rejections which all rely on this interpretation.

The Examiner has not relied upon any of the other applied references to correct this deficiency of Blette (*e.g.*, the Examiner has not relied upon Hess in the rejection of claim 20 to teach or suggest this feature). Accordingly, all of the Examiner's rejections are reversed.

ORDER
REVERSED

sld

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